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	First Named Inventor	Takuya MATSUMOTO	
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Date	September 6, 2007	Reg. No.	40,949



Docket No.: HOK-9022/CON
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Takuya Matsumoto et al.

Application No.: 10/718,660

Confirmation No.: 1610

Filed: November 24, 2003

Art Unit: 3622

For: SYSTEM AND METHOD OF ARRANGING
DELIVERY OF ADVERTISEMENTS OVER A
NETWORK SUCH AS THE INTERNET

Examiner: D. Champagne

REPLY BRIEF UNDER 37 C.F.R. §41.41

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is a Reply Brief under 37 C.F.R. §41.41 in response to the Examiner's Answer mailed on July 6, 2007.

All arguments presented within the Appeal Brief of January 30, 2007 are incorporated herein by reference. Additional arguments are provided herein below.

The Examiner's answer supports the rejection of claims 25-39 under 35 U.S.C. §103(a) as allegedly being unpatentable over Gerace (U.S. Patent No. 5,848,396) ("Gerace") in view of Domine et al. (U.S. Patent No. 5,949,419) ("Domine"). At pages 4 and 5, the Examiner's Answer appears to assert that Gerace teaches all of the elements recited in claims 25, 36, and 37, except for a page access number and a proceeder rate. At page 5, the Examiner's Answer appears to assert that these elements missing from the teachings of Gerace would be obvious to one having ordinary skill in the art in view of Domine. These erroneous conclusions are based upon an inaccurate reading of explicitly defined claim terms and an improper reading of the cited art. As explained in further detail herein, the teachings of Gerace are limited to describing the services of a media owner (i.e., a provider of so-called "agate" information), while

Applicants' claimed invention comprise the services of a media owner, an agent, and an advertiser.

Gerace relates to a computer network method and apparatus for providing targeting of appropriate audience based on psychographic or behavioral profiles of end users. As described in column 3, lines 57-62 of Gerace, this invention is a software program **31** operated on and connected through a server **27** to the Internet for communication among the various networks **19** and/or processors **11, 13, 15, 17** and other end users connected through respective servers **25**. In addition, the program **31** in its most general form has an agate data assembly **71**, a user profiling member **73**, an advertisement module **75** and a program controller **79**, as illustrated in Fig. 2. As described in column 5, lines 26-39 of Gerace, for each of the sponsor submitted advertisements, the advertisement module **75** (and/or the user profiling member **73**) records (a) the number of times and/or number of users to whom the advertisement has been displayed, (b) the number of times/users who have requested more information (via a click of a mouse on a corresponding menu selection) regarding the advertisement, and when possible (c) the number of purchases obtained through program **31**'s display of the advertisement. The advertisement module **75** holds performance data for each advertisement. The program controller **79** provides performance reports to sponsors who log on to the program **31**. Thus, Gerace is characterized by estimating the effectiveness of each of the sponsor submitted advertisements according to the performance reports.

On the other hand, in the present invention, an advertisement (ad) space **201** (i.e., a "space[] for sale for advertisement such as an add [sic] expression and an ad banner" as described at page 7 of Applicants' specification) for placing a desired advertisement of an advertiser is provided on a network media of a media owner (i.e., a "mailing magazine, an opt-in mailing service, a web-site or any other network media affording ad spaces" as described at page 7 of Applicants' specification), which is different from a web site of the advertiser, as shown in Fig. 1. In this case, a user can proceed an entrance page of the advertiser's web site through the ad space **201** (e.g. by clicking the ad space). In the present invention, the page access number is the number of accesses, which are made by the users entered in the entrance page linked from the ad space, and the action access number is the number of accesses, which are made by the users entered in an action page linked from the entrance page. In addition, the result number of the present invention is the number of actions, which are made by the users entered in the advertiser's web site through the ad space in response to an action object for

necessitating processing at an action process module of the advertiser's web site. Therefore, they mean that the numbers of accesses, which are made by the users entered in the advertiser's own web site through the ad space provided on the media owner's web site are used to prepare a statistical report including the proceeder rate and the completer rate of the present invention. In other words, the numbers of accesses, which are made by the users entered in the advertiser's web site not through the ad space or through another ad space, are not used to prepare the statistical report. Therefore, the present invention is characterized by estimating the effectiveness of the ad space placed on the media owner's web site according to the statistical report. As a result, a key money to be paid to the media owner by the advertiser can be determined in response to the estimated effectiveness of the ad space.

Neither Gerace nor Domine teaches or suggest all of the features recited in Applicants' claims, nor would any combination of these references. With regard to claims 25, 36, and 37, the Examiner's answer asserts that Gerace teaches "a response measurement module counting the number of specific responses made at a web site of an advertiser" at column 6, line 41 to column 7, line 22 and column 3, lines 57-62. However, Gerace fails to teach this feature. Column 3, lines 57-62, of Gerace teaches:

The present invention is a software program 31 operated on and connected through a server 27 to the Internet for communication among the various networks 19 and/or processors 11, 13, 15, 17 and other end users connected through respective servers 25.

Essentially, this passage merely teaches that software program 31 is connected to the Internet, as it is understood by any person having ordinary skill in the art. Column 6, line 41, to column 7, line 22, of Gerace teaches:

The history of user activity with executed program 31 is also maintained by the set of User Objects 37 (FIG. 3a). Specifically for each user, a User Session Object 37d, User Action History Object 37e and User Viewing History Object 37f record the following as illustrated in FIGS. 3e-3g.

Each time a user logs on to program 31, User Session Object 37d records the starting date and time and ending date and time of the session. User Session Object 37d also records (a) the referring link from which the user accessed program 31 (e.g., a so called "bookmark" or "hyperlink" which effectively stores and forwards the Web site address of program 31), (b) the user's identification number (e.g., as stored in a so called "cookie" passed by the user's computer upon logging in), and (c) an indication of Web browser software employed by the user's computer. FIG. 3e illustrates the records created by User Session Object 37d to accommodate the foregoing data.

The User Action History Object 37e stores each click of a mouse and corresponding cursor position to effectively record the user's motions/movements in a session. In particular, as illustrated in FIG. 3f, User Action History Object 37e records (a) date and time of action, (b) session identifier (indicating in which session of the User Session Object 37d the subject action occurred), (c) sequence or order number of the action in the series of actions that occurred in a

common session, (d) identification of screen view displayed at time action occurred, (e) identification of item selected by user (via click of mouse with cursor positioned on item), and (f) screen position of selected item (e.g., first, second or third menu item, right or left side).

The User Viewing History Object 37f stores information indicative of the screen views displayed to the user in a session. Specifically, User Viewing History Object 37f records an item identification (either agate or advertisement) and orientation of that item for each item displayed to (and hence viewed by) the user in a session. Orientation is noted relative to a page/screen view or an object identified in the "related object ID" field of the User Viewing History Object 37f. Preferably, orientation is indicated as being top, bottom, left, right or background of the screen view. The Viewing History Object 37f also records an identifier (of each screen view), ordinal sequence number (number order of screen view within series of screen views displayed in a session), and an indication of the action from which this screen view resulted (i.e., a reference to a corresponding User Action History Object 37e). Lastly, the User Viewing History Object 37f records date and time of screen opening and closing for each screen view. The foregoing is stored in an object table record illustrated in FIG. 3g.

At best, this passage teaches counting the actions made *within program 31*, which operates on server 27 and is not part of a website of an advertiser. The Examiner's answer also asserts that program 31 reads on "a web site of an advertiser through an ad space," supporting this incorrect assertion with passages showing that program 31 *contains* ad spaces. If there is any correspondence between program 31 of Gerace and the elements of Applicants' claims, it is at best with the recited "network medium," which also *contains* ad spaces. There is no suggestion in Gerace that program 31 is accessed through an ad space, or that it is a website of an advertiser. Nowhere in Gerace is any suggestion made of monitoring user activity at the website of an advertiser; the only monitoring taught by any portion of Gerace is at program 31. Thus Gerace fails to teach or suggest the claimed response measurement module.

Furthermore, Gerace teaches nothing regarding the nature of the website of the advertiser (i.e., what a user sees as a *result* of clicking on an ad space). The Examiner's Answer at page 5 asserts that the recited entrance page and action page read on the "Home Page" and "Financial Pages, etc." of Gerace, respectively. The Home Page of Gerace is part of program 31, which is not part of a website of an advertiser, as discussed, *supra*. Furthermore, there is no suggestion in Gerace that the Home Page is linked from [an] ad space. The Examiner's Answer apparently equates this limitation with *containing* ad spaces. However, this inverts the relationship recited in the claims. Thus, the Home Page of Gerace clearly does not read on the entrance page recited in Applicants' claims. Similarly, the "Financial Pages, etc." taught by Gerace are also a part of program 31, and not a part of a website of an advertiser. Furthermore, the Financial Pages, etc. of Gerace are linked from the Home Page (*arguendo*, network media), and not an entrance page. Thus, the Financial pages, etc. of Gerace clearly do not read on the action page recited in

Applicants' claims. Still further, the Examiner's Answer provides *no support* for the assertion that Gerace teaches "an action process module which responds to said specific action for processing the same." Even if one were to ignore the clear differences between Home Page / Financial Pages, etc. and the recited entrance page / action page, there is no analog to the recited action process module taught anywhere in Gerace.

Because Gerace fails to teach an entrance page, action page, or action process module, it also inherently fails to teach a page access number, an action access number, and a result number. The Examiner's Answer asserts that "the number of viewers of each ad" (i.e., "hits" as used in Gerace in column 12, lines 11-12) reads on the action access number. This assertion is clearly erroneous: hits describes the number of passive views of an advertisement (for example, when the Home Page is displayed with a banner advertisement, the mere display of that advertisement on a user's screen would count towards hits), while the action access number describes the number of users that have not only followed a link from the advertisement (to the entrance page), but followed a second link from the entrance page to the action page. Thus, the mere "number of *viewers* of each ad" (emphasis added) cannot read on the claimed action access number. The Examiner's Answer also asserts that Gerace teaches a result number at column 5, lines 25-34. That passage teaches:

In addition, for each advertisement, advertisement module 75 (and/or user profiling member 73) records (a) the number of times and/or number of users to whom the advertisement has been displayed, (b) the number of times/users who have requested more information (via a click of a mouse on a corresponding menu selection) regarding the advertisement, and when possible (c) the number of purchases obtained through program 31's display of the advertisement.

It is unclear which of these recorded data (a, b, or c) the Examiner's Answer purports to read on the result number. Regardless, Gerace does not suggest that any of these data reflect actions "made in response to an action object for necessitating processing at said action process module." As already discussed, *supra*, Gerace does not suggest an action process module at all; neither does Gerace suggest any sort of action object. Inherently, Gerace cannot possibly teach recording the number of times responding to a first untaught element since it also requires processing by a second untaught element. The Examiner's Answer further asserts that the claimed page access number reads on traffic data of program 31, as taught in column 6, lines 46-48, of Gerace. As discussed, *supra*, program 31 is not a website of an advertiser. Also, the tracking of any traffic data by program 31 does not suggest monitoring traffic of the advertisers website, let alone a specific page of the advertiser's website.

The Examiner's Answer claims that Domine teaches "that traffic is important to the success of a website." At page 8, the Examiner's Answer asserts that "the web page access data acquired by Gerace should be aggregated . . . and reported with other aggregates taught by Gerace." While that may be true, it would not suggest reporting the page access number as recited by the claims, because none of the data aggregated by Gerace contributes to the page access number. In other words, traffic to the Home Page of Financial Pages, etc. is not related to the page access number, which is the number of the accesses to the entrance page of the website of the advertiser. The Examiner's Answer further states that the claimed page access number is suggested by Domine because it teaches "increased traffic at a Web Site is directly related to the Site's ability to charge increased amounts for electronic advertising." However, the page access number reflects traffic to the website of the advertiser. The page access number clearly has no relation to the advertiser's ability to charge [itself] increased amounts for [its own] electronic advertising. While the teachings of Domine may motivate the aggregation of some traffic data, they do not motivate aggregating the recited page access number.

In failing to teach or suggest the page access number, action access number, and result number as recited in claims 25, 36, and 37, the combination of Gerace and Domine also fails to teach the proceeder rate and completer rate, which are derived from these numbers. The Examiner's Answer at page 7 characterizes the proceeder rate as the "[f]raction of entrance page accesses converted to action pages accesses," and the completer rate as the "[f]raction of entrance page accesses converted to actions." First, Applicant points out that these characterizations, by the explicit language of claims 25, 36, and 37, are incomplete. The proceeder rate could be more accurately characterized as the ratio of accesses to the action page to accesses to the entrance page *during a predetermined period of time*. The completer rate could be more accurately characterized as the ratio of actions made *in response to an action object for necessitating processing at said action process module* to accesses to the entrance page *during a predetermined period of time*. Second, as discussed, *supra*, Gerace fails to teach the entrance page, action page, and action processing module necessary for aggregating the page access number, action access number, and result number. Therefore, Gerace cannot be said to teach the recited ratios. It is also unclear how "a graphic comparison of [geographic] user density versus [geographic] click through or purchase density," cited in the Examiner's Answer as reading on the completer rate, teaches anything regarding the recited page access number or the number of actions made necessitating processing at said action process module. The

Examiner's Answer appears to focus on the presentation of these numbers at pages 7-8. However, the presentation is somewhat irrelevant when the underlying statistical data is not taught.

Page 10 of the Examiner's Answer alleges that some of the recited claim terms are not found in patent databases and are thus ambiguous ("hardly unambiguous"). Regardless of whether "proceeder rate," "completer rate," "page access number," and "action access number" are found within other patent literature, they are clearly defined in both the specification of the instant application and the language of the claims themselves.

Regarding claim 26, neither Gerace nor Domine teach anything regarding "downloading a file or software from said web site; applying for a prize offered by the advertiser on said web site; answering to a questionnaire from the advertiser on said web site; requesting a catalogue from the advertiser through said web site; requesting a subscription to a newsletter from said web site; [or] signing up a membership of a club managed by the advertisers through said web site." The Examiner's Answer incorrectly claims at page 6 that all of these features are inherently taught by Gerace. While Gerace at best may only teach "clicking through to said web site", none of these features are taught or suggested by Gerace, nor are they inherent to any teachings of Gerace.

Regarding claim 31, neither Gerace nor Domine teach "a referrer table listing a ranking of referred URLs which lead to the action process module through said entrance page and said action page." The referred URL data taught by Gerace as cited in the Examiner's answer merely regards the URL viewed immediately before the "Home Page" of program 31 in order to build a psychographic profile. The referred URL data taught by Gerace does not indicate which URLs lead to the web page of the advertiser. By contrast, the recited referrer table indicates which media pages are most successful at directing users to the advertisers' web pages.

Conclusion

For at least the reasons set forth hereinabove, the rejection(s) of the claimed invention should not be sustained. Therefore, a reversal of the Final Rejection of January 13, 2006 is respectfully requested.

If any fee is required or any overpayment made, the Commissioner is hereby authorized to charge the fee or credit the overpayment to Deposit Account # 18-0013.

Dated: September 6, 2007

Respectfully submitted,

By 

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